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Mitch Fredrick Singer

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PROCOPIO, CORY, HARGREAVES & SAVITCH LLP

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SAN DIEGO, CA 92101

EXAMINER

DUNN, DARRIN D

ART UNIT

PAPER NUMBER

2121

NOTIFICATION DATE

DELIVERY MODE

05/01/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/686,956	Applicant(s) SINGER ET AL.	
	Examiner DARRIN DUNN	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/31/07 02/01/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the communication filed on 02/01/2008.
2. Claims 1-39 are presented for examination. Claim 40 has been withdrawn from further consideration.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 9-24, 26-33, 35, and 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Peinado et al. (USPN 20030217011).
5. As per claim 1, Peinado et al. teaches a method of presenting content data, comprising:
 - receiving at a client ([FIG 1-element 14]) connected to a hub network ([FIG 1-element 10]) a present request indicating locked content data ([FIG 1- element 12p], [0018], [0113] e.g., user requests a license that binds the discrete content and license to a ‘black box’. It is interpreted that the request is also a request to bind the content);
 - checking a license corresponding to said locked content data to determine if said license permits said client to present said locked content data ([0016-0017], [0108]);
 - wherein said locked content data is a bound instance if said license permits presentation of said locked content data by said client connected to a hub network ([0017-19], [0107]); and

presenting said locked content data through a presentation component connected to said client wherein when said locked content data is a bound instance ([0019], [0107])

6. As per claim 2, Peinado et al. teaches the method of claim 1, wherein:
said locked content data and said license are stored on said client ([0019 –DRM license store] e.g., downloaded license, [FIG 4-element 32])

7. As per claim 3, Peinado et al. teaches the method of claim 2, wherein:
presenting said locked content data includes decrypting said locked content data to produce output content data and sending said output content data to said presentation component ([0019])

8. As per claim 4, Peinado et al. teaches the method of claim 1, wherein said locked content data is stored on a server ([FIG 1-element 22], [0078])

9. As per claim 5, Peinado et al. teaches the method of claim 1, wherein:
checking said license includes sending a confirm license request to said server from said client ([0017-19] e.g., client machine sends the black box a public key, version number, and signature to the license server, i.e., confirmation)

10. As per claim 6, Peinado et al. teaches the method of claim 5, wherein:
presenting said locked content data includes receiving output content data streamed from said server to said client ([0072], [0074])

11. As per claim 7, Peinado et al. teaches the method of claim 5, further comprising:
checking a revocation list to determine whether said client is included in said revocation list ([0062], [0157] e.g. revocation list, not defined, is interpreted as permission associated with digital content - 12p. Furthermore, a list of ‘bad’ users’ is additionally stored)

wherein said revocation list is stored on said server ([0062], [0078-79] e.g., since 12p is provided via a content server, it is understood that such list is stored on the server)

12. As per claim 9, Peinado et al. teaches the method of claim 1, wherein: said locked content data is media data ([FIG 1-12p])

13. As per claim 10, Peinado et al. teaches the method of claim 1, wherein: said presentation component is integral to said client ([0107])

14. As per claim 11, Peinado et al. teaches the method of claim 1, wherein said presentation component is external to said client ([0107] e.g., dedicated viewing device - monitor)

15. As per claim 12, Peinado et al. teaches the method of claim 1, wherein said presentation component includes a television ([0107])

16. As per claim 13, Peinado et al. teaches the method of claim 1, wherein: said presentation component includes an audio speaker system ([0107])

17. As per claim 14, Peinado et al. teaches a method of presenting content data, comprising: receiving at a server connected to a hub network a present request indicating locked content data and indicating to a client in-connected to said hub network to present the content data ([0018-19]);

checking a license corresponding to said locked content data to determine if said license permits said server to present said locked content data through said client ([0019]);

wherein said locked content data is a bound instance if said license permits presentation of said locked content data by said server through said client connected to a hub network ([0016-0019]); and

presenting said locked content data by streaming data to said client ([0072]);
of when said locked content data is a bound instance ([0019]).

18. As per claim 15, Peinado et al. teaches the method of claim 14, wherein:

streaming data to said client includes streaming locked content data to said client ([0072])

19. As per claim 16, Peinado et al. teaches the method of claim 14, further comprising:
decrypting said locked content data ([0019])

20. As per claim 17, Peinado et al. teaches the method of claim 14, wherein said present
request is received from said client ([0019])

21. As per claim 18, Peinado et al. teaches the method of claim 14, further comprising:
checking a revocation list to determine whether said client is included in said revocation
list; ([0157])

wherein said revocation list is stored on said server ([0157])

22. As per claim 19, Peinado et al. teaches a method of copying content data, comprising:
receiving in a hub network a copy request indicating locked content data; and copying said
locked content data to produce a copy of said locked content data;-when said locked content data
is a bound instance with a corresponding license that is bound to said hub network ([0009],
[0014], [0060], [0119], [0144])

23. As per claim 20, Peinado et al. teaches the method of claim 19, further comprising:
checking said license to determine if said license permits said locked content data to be
copied ([0014])

24. As per claim 21, Peinado et al. teaches the method of claim 19, further comprising:
requesting a new license from a server for said copy of said locked content data; wherein said

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server is in said hub network and connected to said client ([0144] – purchasing a new license], [0174] e.g. license re-issue))

25. As per claim 22 Peinado et al. teaches the method of claim 19, further comprising: sending said copy of said locked content data to a device that is not a member of said hub network ([0107] e.g., member is not defined, is interpreted as either a network connection and/or a membership in terms of being an authorized license recipient. A stand alone device, i.e., music player, is not understood as being a member of a network due to the fact it is not assigned an IP address. Further clarification of ‘membership’ is appreciated)

26. As per claim 23 Peinado et al. teaches the method of claim 19, further comprising: sending said copy of said locked content data to a client that is a member of said hub network but is not connected to said hub network ([0107] e.g., a stand-alone device, for example, may be a member in the sense of being an authorized license recipient but is not networked via an IP address to the network. Further clarification as to what defines a ‘member’ is requested)

27. As per claims 24 and 35, Peinado et al. teaches the method of claim 19, further comprising:

sending a new license to a client that is a member of said hub network but is not connected to said hub network ([0107], [0127], [0132] e.g., new license is interpreted as receiving a first instance of a license. In the case of a CD player or other stand-alone device, a network connection may not exist however a membership may exist in the sense that the player, upon receiving a license, is an authorized client at this particular point. In another interpretation, a connection may be lost to the network due a potential loss of device power. Although a device

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may be a member, it may be connected. Further clarification of both 'membership' and 'connection' type is requested.)

28. As per claim 26, Peinado et al method of distributing content data, comprising: receiving from a providing device connected to a hub network and at a receiving device a copy of locked content data that is a bound instance bound to said hub network ([0016-0019]); requesting a new license for said copy of locked content data ([0019] e.g., new license is interpreted as the first instance of a downloaded license for protected content); and receiving said new license for said copy of locked content data of the bound instance to said hub network ([0019], [0017] e.g., receiving license, i.e., downloading, that is bound to said hub network)

29. As per claim 27, Peinado et al teaches the method of claim 26, wherein said providing device is a client in said hub network ([FIG 1-element 30] e.g., client device, not defined, may be interpreted as a black box that serves as a providing device in the sense it serves as an intermediary in providing a license. As part of the network, it is further understood as a client)

30. As per claim 28, Peinado et al teaches the method of claim 26, wherein said providing device is a server in said hub network ([FIG 1-element 22 | 24])

31. As per claim 29 Peinado et al teaches the method of claim 26, wherein said new license is received from said client ([0110] DRM acquisition)

32. As per claim 30, Peinado et al teaches the method of claim 26, wherein: said new license is received from a server in said hub network ([FIG 1-24])

33. As per claim 31, Peinado et al teaches the method of claim 26, wherein: said new license is received from an external server that is not in said hub network ([0147])

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34. As per claim 32, Peinado et al teaches the method of claim 26, wherein:

said copy of locked content data has corresponding licensing authority information stored on said device ([0084-0089], [0091], [0019- license store) and

said new license is received from a licensing authority indicated by said licensing authority information ([0020] e.g., determination that application is allowed via DRM)

35. As per claim 33, Peinado et al teaches the method of claim 26, wherein:

said receiving device is not a member of said hub network ([0107] e.g., a member, not defined,

may be interpreted as either a networked device and/or a device that is authorized to render

material via a license. Until a stand-alone device receives a license, it is not a member of the

network. Therefore, a stand-alone device (music player), for example, is not a member of until it

receives a license, in effect, a member is a function of when it receives a license)

36. As per claim 37, Peinado et al teaches the method of distributing content data,

comprising:

receiving at a server connected to a hub network ([FIG 1-24], [0098], [0111] e.g., new license,

not defined, is interpreted as either a re-issue of a current license or the first instance of a license,

i.e., very first license issued), and from a device a request for a new license for a copy of locked

content data that is a bound instance bound to said hub network ([0017], [0018])

checking a root license stored on said server to determine if said root license permits said

server to provide a new license for said copy of locked content data of the bound instance ([FIG

1-24- root license server])and creating said new license according to said root license; sending

said new license to said device ([0018], [0019] e.g., new license is first instance of receiving a

license)

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wherein said new license for said copy of locked content data of the bound instance_{is} bound to said hub network ([0017])

37. As per claim 38, Peinado et al teaches the method of claim 37, wherein said device is not connected to said hub network ([0107] e.g., music player. 'connection,' not defined, needs further clarification because a device may not be connected in the sense of a power issue, offline use, IP association, considered to lack the permission to attach to the network, or possibly leaves the coverage range of the network (wireless), among other things)

38. As per claim 39, Peinado et al. teaches the method of claim 37, further comprising: checking a revocation list to determine whether said device is included in said revocation list ([0157]);

wherein said revocation list is stored on said server ([0157]).

Claim Rejections - 35 USC § 103

39. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

40. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

41. Claims 8, 25, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. (USPN 20030217011) in view over Evans et al. (USPN 20030236978)

42. As per claims 8, 25, and 36, Peinado et al. does not disclose that a revocation list is stored on said client; however, Evans et al. teaches that a revocation list is transmitted to a client who can send the revocation list down the processing chain to a remote device ([0144])

43. Therefore, at the time the invention was made, one of ordinary skill in the art would have motivation to include a revocation list in a client such that components that are revoked will no longer be able to process the protected data. The combination of a revocation list stored locally at a client juxtaposed to a server provides not only additional redundancy in the form of a back-up list but also as means in which a client device may update a list of which components have been revoked as taught by Evans et al.

44. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. (USPN 20030217011) in view over Capitant (USPN 20030078891)

45. As per claim 34, Peinado et al. teaches a receiving device and that a copy of said locked content is bound to a hub network, (supra claim 1); however, Peinado et al. does not teach where a receiving device is a member of a second hub network and that such locked content data is bound to said second hub network. Capitant teaches that content may be moved for consumption outside the consumer's authorized domain)

46. Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to apply the mechanisms in which content is bound to a particular hub as

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taught by Peinado et al. to an outside network, i.e., second hub network. Since it is foreseeable that content may be consumed outside an authorized domain, it is therefore necessary to protect the content via binding such content to a network. The application of Peinado et al. to Capitant would produce a predictable result of not only binding content to an outside network, but also enabling an outside device to render the protected content within the outside network.

Conclusion

47. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20030078891 – pertinent to the type of attachment or connection

20040102987 – pertinent to maintaining copies

48. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARRIN DUNN whose telephone number is (571)270-1645. The examiner can normally be reached on EST:M-R(8:00-5:00) 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DD
04/25/2008

/Albert DeCady/
Supervisory Patent Examiner
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